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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,989	10/20/2005	Mickael Allain	5284-55PUS	2271
27799 7590 01/28/2009 COHEN, PONTANI, LIEBERMAN & PAVANE LLP 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176				
EXAMINER				
CHAI, LONGBIT				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,989

Applicant(s)

ALLAIN ET AL.

Examiner

LONGBIT CHAI

Art Unit

2431

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. Currently pending claims are 1 – 16.

Response to Arguments

2. Applicant's arguments with respect to instant claims have been fully considered but are moot in view of the new ground(s) of rejection necessitated by Applicant's amendment.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. As per claim 1 and 11, Examiner notes the new matter of "comparing the *parameters* extracted from the decrypted control code with corresponding information stored in a database", which was added into the claim limitation in the amendment filed on 12/11/2008 that was not originally filed on 3/31/2005, is rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. According to the disclosure of the instant specification, to verify the identity of the sender of the call, the call server decrypts the control code inserted into the frame, recovers the MAC identification code and the IP address of the gateway or the calling terminal, and then compares, firstly, the MAC address recovered from the frame sent by the calling terminal with the corresponding MAC address stored in the database and, secondly, the IP address obtained by decrypting the control code with the IP address *in clear form (i.e. unencrypted) carried by the frame (i.e. packet)* and the call is authorized if the data matches (SPEC: Page 7 Line 12 – 22 and Page 2 Line 26 – 28: comparing a parameter stored in a

database (i.e., NOT parameters)) – Examiner notes the invention subject matter discloses the extracted parameters from the control code are not all compared with the parameters stored in the database and instead, ***only the MAC address is compared with the one stored in the database (throughout the entire specification)*** while other parameter(s) is compared against the one which is presented in clear form (i.e. unencrypted) carried in the call setup frame / packet (NOT the one stored in the database) and as such the amended claim limitations “comparing the ***parameters*** extracted from the decrypted control code with corresponding information stored in a database” raises the issue of the new matter as set forth above. Any other claims not addressed are rejected by virtue of their dependency. On this regard, Examiner respectfully notes Applicant is requested to clearly identify the associated amendments in each of the dependent claims and clearly indicate the passages of the original application as filed on which these amendments are based.

4. As per claim 11, Examiner notes the new matter of “a call management server configured to initiate setup of a call”, which was added into the claim limitation in the amendment filed on 12/11/2008 that was not originally filed on 3/31/2005, is rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. According to the disclosure of the instant specification (SPEC: Page 6 Line 2 – 6 and Page 7 Line 27 – 29: a call management server never initiates a call setup (i.e. only a calling subscriber can initiate a call setup request) and in fact, the server merely cooperates and sets up (i.e. establishes) a call setup between a calling and called parties). Any other claims not addressed are rejected by virtue of their dependency.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 – 2 and 11 – 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Haukka et al. (U.S. Patent 2003/0097584).

As per claim 1 and 11, Haukka teaches a method of verifying the identity of the sender of a telephone call over an Internet network, said method comprising the following steps:

inserting into a field of a call set-up request frame an encrypted control code containing parameters relating to the identity of a telecommunications terminal from which the telephone call is sent (Haukka: Para [0009] Line 1 – 4 / Line 8 – 9, Para [0023] Line 5 – 7 and Para [0017] Line 23 – 26: (a) the temporary identity index is qualified as a control code (b) the temporary identity index (control code) is inserted and encrypted in a secured SIP message and (c) the temporary identity index (control code) includes a public identity of a user equipment / terminal);

a remote call management server decrypting the control code (Haukka: Figure 2 & Para [0009] Line 1 – 4 / Line 8 – 9, Para [0023] Line 5 – 7 and Para [0017] Line 23 – 26: P-CSCF is a proxy server);

comparing at least one parameter extracted from the decrypted control code with corresponding information stored in a database hosted in the server (Haukka: Para [0017]

Line 32 – 35: the temporary identity index (control code) is stored in a database of the visiting network); and

setting up the call as a function of the result of said comparison (Haukka: Para [0009]: SIP message is used to establish an internet session call between the calling and called parties after the successful validation of SIP security parameters).

As per claim 2 and 12, Haukka teaches comparing parameters extracted from the decrypted control code with corresponding information extracted from the call set-up request frame (Haukka: Para [0009] Line 1 – 4 / Line 8 – 9, Para [0023] Line 5 – 7 and Para [0017] Line 23 – 26).

As per claim 13, Haukka teaches including a verification module adapted to insert an encrypted control code into a call set-up request frame (Haukka: Para [0009] Line 1 – 4 / Line 8 – 9, Para [0023] Line 5 – 7 and Para [0017] Line 23 – 26).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 – 10 and 14 – 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haukka et al. (U.S. Patent 2003/0097584), in view of Hirayama et al. (U.S. Patent 2003/0123434).

As per claim 6 and 9, Haukka teaches the control code is produced from an encrypted function associated with the user terminal (Haukka: Para [0023] Line 5 – 7 and Para [0009] Line 7 – 9).

However, Haukka does not disclose expressly an address identifying the terminal and the IP address of the terminal.

Hirayama teaches an address identifying the terminal and the IP address of the terminal (Hirayama: Para [0002] Line 9 – 15: terminal IP address is used for authentication purpose during a call setup of Voice over IP (or internet initiated session call)).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Hirayama within the system of Haukka because (a) Haukka teaches providing a method for confidentiality protection in a session initiation protocol message (SIP: an internet call with session initiated protocol) transmitted between user equipment and network element in a communication network (Haukka: Para [0002]), and (b) Hirayama teaches providing a method of initiating a secured internet call while providing the benefits a cost reduction attributable by originating a call from an IP terminal (identified by its IP address) and authenticating of the calling terminal to achieve a call setup (Hirayama: Para [0002]).

As per claim 3, Haukka as modified teaches the information stored in the database includes an address identifying the terminal (Haukka: Para [0023] Line 5 – 7 and Para [0009] Line 7 – 9) & (Hirayama: Para [0002]). See the same rationale of combination applied herein as above in rejecting the claim 6.

As per claim 4, Haukka as modified teaches the said information is transferred from the terminal to the database during a first call sent by the terminal (Haukka: Para [0023] Line 5 – 7 and Para [0009] Line 7 – 9).

As per claim 5 and 14, Haukka as modified teaches the information extracted from the call set-up request frame includes the IP address of the terminal (Hirayama: Para [0002]) and the calling number of the terminal (Haukka: Para [0007]: a public information identifying a sender).

See the same rationale of combination applied herein as above in rejecting the claim 6.

As per claim 7, 10 and 16, Haukka as modified teaches the IP address of the terminal is sent by an Internet network access provider to a verification module associated with the terminal (Hirayama: Para [0002] / [0006]).

As per claim 8 and 15, Haukka as modified teaches the IP address of a gateway for connecting a private network to a telecommunications network and the calling number of the terminal (Haukka: Para [0007]) & (Hirayama: Para [0002] / [0006]: a VoIP gateway obviously includes a gateway involved in a private or a public network). See the same rationale of combination applied herein as above in rejecting the claim 6.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LONGBIT CHAI whose telephone number is (571)272-3788. The examiner can normally be reached on Monday-Friday 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2431

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Longbit Chai/

Primary Examiner, Art Unit 2431
12/17/2008